

REMARKS

By this amendment, a Terminal Disclaimer, a substitute specification, including clean and marked up copies, and corrected drawings have been submitted, claims 1 and 5 and the Abstract have been amended to place this application in condition for allowance. Currently, claims 1-8 are before the examiner for consideration on their merits.

Applicants wish to thank Examiner Reichle for granting a telephonic interview on February 14, 2006. During the course of the interview, amendments were proposed to the claims to respond to the issues raised in the Office Action. As a result of the interview, claims 1 and 5 are further amended to clarify the position of the elastic member and distinguish over the prior art. In the interview, the Examiner expressed the view that the "distal end portion" of the supplementary batt structure is interpreted as a length of the structure, not just a free end of the batt structure. With this interpretation, the Examiner felt that the language in the claims stating that the elastic member was aside the distal end portion or midway between the distal end portion and proximal end portion was unsupported and/or confusing. Thus, claims 1 and 5 are revised to state that the distal end portion has a free end and that the elastic member is between the free end of the distal end portion and the proximal end portion of the supplementary batt structure. Support for this change can be found in at least Figure 2 of the drawings.

Claims 1 and 5 are also revised to clarify that the elastic member is spaced from the two batt structures in the contraction state of the member as also shown in Figures 2 and 3.

Turning now to the prior art rejection, it is respectfully contended that the applied art does not establish a *prima facie* case of obviousness against claim 1. In review, the

claims 1-4 and 8-12 are rejected under 35 U.S.C. § 103(a) based on Paragon when taken in view of Dreier and Rönnerberg. Claims 5-7 are rejected based on these three references and Onishi. The Examiner asserts that it would be obvious to use the elastic members of Dreier and Rönnerberg in the Paragon diaper, and further modify Paragon with two supplemental batt structures given Onishi. The Examiner also notes that the claims do not require that the elastic member be placed between the two batt structures or that it is directly connected to the batt structures at its end.

The reasons in support of the patentability of these claims are two fold. The first reason is that claim 1 defines the elastic member as being between the two batt structures and spaced from between the free end of the distal end portion and the proximal end portion. This arrangement is not found in the applied prior art; each of the members 154 of Dreier and 34 of Rönnerberg is located at the free end of the batt structure and are not between the batt structure's free end and its proximal end portion.

The second reason is that the claims now also define the elastic member as having opposing surfaces that are spaced from the batt structures in the contracted state. This feature is also not found in the Rönnerberg or Dreier references, and these references do not supply the missing parts of Paragon.

Since the applied references fail to teach or suggest the disposable diaper as now defined by claim 1, the rejection based on 35 U.S.C. § 103(a) must be withdrawn. Since each of the remaining claims is ultimately dependent on claim 1, these dependent claims are also in condition for allowance.

In addition, there is no basis for the Examiner to further modify the teachings of Rönnerberg and Dreier and allege that it would be obvious to relocate the elastic members

of this prior art so as to arrive at the invention. As the Examiner knows, a rejection based on 35 U.S.C. § 103(a) must have the requisite motivation to make a modification of the prior art. The only source of motivation to modify Rönnerberg and/or Dreier would be Applicants' own teachings, and this type of source cannot be used to support a rejection under 35 U.S.C. § 103(a).

DOUBLE PATENTING

Applicants also submit a Terminal Disclaimer in this application and this removes the obviousness-type double patenting rejection.

SUMMARY

By the amendments and arguments made above, each and every issue raised in the outstanding Office Action has been resolved. The changes to the drawing and specification remove all of the objections. The changes to the claims and specification remove the rejection under 35 U.S.C. § 112, first paragraph. Further, the prior art fails to establish a *prima facie* case of obviousness against claim 1, as amended.

Therefore, the Examiner is respectfully requested to examine this application in light of this amendment, and pass all pending claims 1-8 onto issuance.

If the Examiner believes that an interview with Applicants' attorney would be helpful in expediting prosecution of this application, the Examiner is invited to telephone the undersigned at the number set forth below.

The above constitutes a complete response to all issues raised in the Office Action of November 29, 2005.

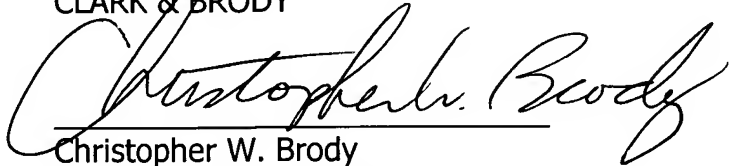
Serial No.: 10/082,211

Again, reconsideration and allowance of this application is respectfully requested.

The fee of \$130.00 for the Terminal Disclaimer is attached herewith.

Please also charge any fee deficiencies or credit any overcharges to deposit account no. 50-1088.

Respectfully submitted,
CLARK & BRODY

A handwritten signature in cursive script, reading "Christopher W. Brody", written over a horizontal line.

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